

applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough.

Nevertheless, when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other claim under 37 CFR 1.75 as being a substantial duplicate of the allowed claim.

M.P.E.P. § 706.03(k). Claims 72-75, directed to “an isolated polypeptide comprising a fragment of the amino acid sequence” encoded by the deposited cDNA, are not duplicates of claims 76-79, directed to “an isolated polypeptide comprising the active site” encoded by the deposited cDNA (emphasis added). Nor are these claims “so close in content that they both cover the same thing”. Clearly the scope of claims 72-75 differs from the scope of claims 76-79. Accordingly, Applicants respectfully submit that the allowance of claims 72-75 should not preclude the allowance of claims 76-79 on the basis of being duplicative.

#### **Claim Rejections under 35 U.S.C. § 112, first paragraph – Enablement**

Claims 40-59 remain rejected under 35 U.S.C. § 112, first paragraph as allegedly not enabled for proteins 90% and 95% identical to TGFalpha HIII. In particular the Examiner alleges that “the instant application is not enabling because one cannot, following the guidance presented therein, practice the suggested method without first making a substantial inventive contribution.” See Paper No. 23 at page 3. Applicants respectfully disagree and traverse the rejection.

Applicants maintain that the specification fully enables one of ordinary skill in the art to routinely make and use the claimed polypeptides without undue experimentation. The specification provides ample guidance, including, for example, structural features and preferred epitopes, as to which regions of the TGFalpha HIII polypeptide may be altered with a reasonable expectation of success. See, *e.g.*, page 10, line 19 through page 11, line 3; Table I at pages 45-48; and Figures 2 and 3. Furthermore, the specification provides methods of assaying the activity of TGFalpha HIII variants and raising antibodies thereto. See, *e.g.*, Example 53 at pages 268-270. In view of the teachings of the specification and level of skill in the art, it would have been routine to produce polypeptides 90% and 95% identical to TGFalpha HIII which retain biological activity. Accordingly, Applicants submit that claims 40-59 are fully enabled by the disclosure of the instant application, and

respectfully request that the rejection of claims 40-59 under 35 U.S.C. § 112, first paragraph, be withdrawn.

**Claim Rejections under 35 U.S.C. § 102(b)**

The Examiner alleges that the instant application is not entitled to the benefit of the filing date of parent application 08/778,545, on the basis that the parent application has been found to lack utility and enablement. Accordingly, claims 26-79 of the instant application have been rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/18203 (Kato et al.). Paper No. 23, pages 3-4. Applicants disagree and traverse the rejection.

Applicants maintain that the instant application is entitled to the priority of parent application 08/778,545 because the parent application does not lack utility or enablement, as Applicants have argued in the prosecution of the parent case.

Furthermore, even if Applicants are denied the priority benefit of parent application 08/778,545, the instant application should still be accorded the benefit of provisional application 60/168,387, filed December 2, 1999. The international publication date of WO 99/18203 is April 15, 1999, less than one year before the filing of provisional application 60/168,387. Therefore, since 35 U.S.C. 102(b) pertains to prior art references published more than one year prior to the priority date of the application under examination, WO 99/18203 is not a proper 102(b) reference. Accordingly, Applicant respectfully request that the rejection be withdrawn.

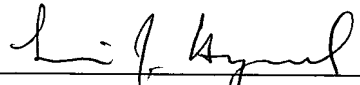
## CONCLUSION

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application. Applicants believe that this application is now in condition for allowance.

If there are any fees due in connection with the filing of this paper, please charge the fees to Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the fee should also be charged to Deposit Account No. 08-3425.

Respectfully submitted,

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Enclosures